YKL Engineering Sdn Bhd v Sungei Kahang Palm Oil Sdn Bhd & Anor

FEDERAL COURT (PUTRAJAYA) — CIVIL APPEAL NO 02(f)-9–02 OF 2021(J)
ROHANA YUSUF PCA, AZAHAR MOHAMED CJ (MALAYA) AND ZAWAWI SALLEH FCJ
8 JULY 2022

Patents — Infringement — Anticipation and novelty — Whether patented invention was not novel or an inventive step but anticipated by prior art that existed before date of filing of the patent — Whether the patent was consequently invalid — Patents Act 1983 s 14(2)(a)

Copyright — Infringement — Test for infringement — Whether copyright subsisting in design drawings pertaining to plaintiff's patented invention was infringed — Whether elements in law for infringement of copyright were satisfied — Whether plaintiff failed to establish defendants had access to plaintiff's design drawings — Whether trial judge in holding there was copyright infringement failed to explain in what way prior art machinery was based on plaintiff's design drawings

The appellant owned a patent filed on 12 January 2006 for a Fruit Bunch Splitter machine ('FBS') used to split oil palm fruits into smaller pieces so that they could be easily processed by oil palm mills. The appellant also claimed it had copyright in the design drawings of the FBS and its component parts. In April 2009, the appellant gave a two-day demonstration of the operation of the FBS in the first respondent's palm oil factory with a view to securing a sale but the first respondent ('R1') found the machine too costly for purchase. Two years later, the appellant discovered that R1 had been operating two machines in its factory which closely resembled the FBS and that the machines ('the SK machines') were bought from the second respondent ('R2') which was in the business of, inter alia, making various types of machinery for factories including palm oil mills. R1 had bought the first SK machine in September 2009 and the second one in January 2010. Claiming that the SK machines had used the invention and specifications in its patent, the appellant sued the respondents in the High Court for infringement of patent and copyright. The respondents denied the allegations and counterclaimed to invalidate the appellant's patent on the ground that: (a) the patented invention was not novel as prior art existed or was disclosed to the public before the patent was filed on 12 January 2006; and (b) the patented invention was obvious and did not involve any inventive step. The prior art that the respondents specifically

pleaded to invalidate the patent were: (i) the drawings of a Kim Loong Machine ('the Kim Loong drawings') created on 1 August 2003; and (ii) a machine comprising the same features that was located and used at the factory of Keck Seng Bhd in 2002 ('the Prototype'). During the trial, the respondents sought to amend their pleadings to plead yet another prior art in the form of the 'Desa Kim Loong Machine', but their amendment application was refused both by the trial court and the Court of Appeal ('COA') on appeal. At the conclusion of the trial, the High Court upheld the appellant's claims for infringement of patent and copyright and dismissed the respondents' counterclaims. In coming to its decision, the trial court did not consider any evidence of the Desa Kim Loong Machine prior art since it was not pleaded. On the respondents' appeal, the COA set aside the whole of the High Court's decision, dismissed the appellant's claims and allowed the respondents' counterclaims. The COA held that the appellant's patent was invalidated by the prior art that existed in the Prototype (which was pleaded) as well as the Kim Loong Machine (which was not pleaded). The COA found as a fact that the appellant's patented invention was not novel or an inventive step but obvious to one who was normally skilled in the relevant art at the material time. The COA also held that copyright did not subsist in the design drawings of the FBS and even if it did, there was no infringement of copyright. The appellant was granted leave to file the instant appeal against the COA's decision on seven questions of law, six of which concerned patent law while the remaining question concerned copyright law. Among the questions was: (A) whether a party intending to challenge the novelty of a patent by relying upon evidence of prior art was required by law to have pleaded with specificity the particulars of such prior art; (B) whether the COA should not have considered evidence of the Desa Kim Loong Machine prior art when it had itself in a prior interlocutory appeal disallowed the respondent from amending its pleading to specifically plead that prior art; and (C) whether the design drawings of the FBS qualified for protection under the Copyright Act 1987 as artistic works.

During the trial, the inventor of the SK machines, DW2, testified that when he was doing contract work at Keck Seng Bhd's factory in 2002, he witnessed first-hand the operation of the Prototype which inspired him to make a similar machine for Kim Loong in 2002/2003. The appellant's employee, PW1, disputed DW2's evidence saying the latter could not have viewed the operation of the Prototype because it was kept a secret and was only accessible to authorised employees of Keck Seng. The trial court made no finding on this conflict of evidence but the COA, after scrutinising the evidence on record, found as a fact that there was public disclosure of the Prototype to DW2 when he was working at Keck Seng's factory and that it was a disclosure that enabled DW2 to use the knowledge he had acquired to make a similar machine for Kim Loong in 2002/2003 as corroborated in the Kim Loong drawings.

With regard to copyright, it was the appellant's case that copyright subsisted in the design drawings of the FBS as they were created by PW1 who had expended substantial effort to render the drawings original in character to qualify them as

A artistic works within the meaning of s 7(1)(c) of the Copyright Act 1987. The respondents, however, denied that any copyright existed on the ground that the design drawings were not original works but were copied from the design drawings of Kim Loong's machine in the year 2003. Even if copyright subsisted, the respondents contended that there was no infringement of it as
B the appellant had failed to satisfy the elements required to establish infringement of copyright. The COA decided that no copyright subsisted in the FBS design drawings and that a case of copyright infringement had also not been made out.

C **Held**, unanimously dismissing the appeal:
On the patent law leave questions:

(1) **(Azahar Mohamed CJ (Malaya))** This court affirmed the specific findings of the COA on the fact that the invention which was the subject
D of the appellant's patent was not new by reason of the prior disclosure of the Prototype at Keck Seng within the meaning and conditions of s 14(2)(a) of the Patents Act 1983 and therefore the appellant's patent was invalid (see para 78).

E (2) **(per Azahar Mohamed CJ (Malaya))** It was a requirement in law for a party to plead with specificity the particulars of prior art that it intended to rely upon to invalidate a patent for lack of novelty or otherwise. Although such requirement was not found in the Patents Act 1983 and the Patent Regulations 1986, the issue had to be decided by reference to
F the Rules of Court 2012, specifically the provision governing the general principles of pleadings in O 18 r 7(1) under which material facts necessary to formulate a complete cause of action or defence must be pleaded. In considering whether a prior art was a 'material fact' that must be pleaded with specificity by a party seeking to invalidate a patent for
G lack of novelty, it had to be noted that a party's expert was required to provide their opinion on the relevant prior art to assist the court on the issue of invalidation of the patent. Validity of the patent had to be assessed by the court with the aid of an expert often referred to as a 'person having ordinary skill in the art' (see paras 35–36 & 42).

H (3) **(per Azahar Mohamed CJ (Malaya))** The COA failed to appreciate that the respondents were relying on items of prior art to invalidate the appellant's patent. For that reason, the importance of giving notice to the appellant by the respondents in respect of the Desa Kim Loong Machine and of specific pleading by the respondents to invalidate the appellant's
I patent could not be over-emphasised. A party attacking the validity of a patent should particularise the prior art in question in the pleading so that the parties and their experts were not taken by surprise but came to trial prepared to meet the case which was intended to be proven against them (see para 37).

(4) **(per Azahar Mohamed CJ (Malaya))** In the present case, neither the appellant nor its experts were afforded the opportunity to scrutinise the Desa Kim Loong Machine in great detail and to submit their written opinions/reports on the same. The respondents' introduction of the non-pleaded Desa Kim Loong Machine (in the form of a CD-ROM) at the eleventh hour and the COA's decision to admit the same into evidence had handicapped the appellant in its defence of their patent's validity. The COA's decision to admit evidence of the Desa Kim Loong Machine and invalidating the appellant's patent based on the same clearly prejudiced and caused injustice to the appellant (see para 41).

(5) **(per Azahar Mohamed CJ (Malaya))** As the respondents did not appeal further after their attempt to amend their pleading to include the Desa Kim Loong Machine prior art was rejected by the COA, the matter became res judicata and the COA could not disregard its previous decision on the point and allow the Desa Kim Loong Machine prior art to be considered in evidence. The COA erred in holding that the trial judge erred in failing to admit into evidence and in not considering the Desa Kim Loong Machine prior art. The trial court was only adhering to the COA's earlier decision to exclude the Desa Kim Loong Machine from the body of prior art (see paras 49–50).

(6) **(per Azahar Mohamed CJ (Malaya))** The COA correctly held from the evidence on record that there was sufficient evidence to establish that the Prototype at Keck Seng had been disclosed to the public within the meaning of s 14(2)(a) of the Patents Act and that the disclosure was an 'enabling' one. On the facts, the disclosure of the Prototype whilst on third-party private premises was clearly not unauthorised. The Prototype was, as found by the COA, incorporated into and formed part of the whole process of mill operations at Keck Seng's premises. DW2 was lawfully on the premises and had easy unrestricted access to the Prototype. There were no security measures or evidence of restrictions to access the same. There was also no evidence of obligation of confidence. DW2 was free in law and equity to examine and use the information disclosed by the Prototype. On the facts, this court was unable to agree with the appellant that the Prototype at Keck Seng was installed confidentially or privately (see para 65).

On the sole leave question concerning copyright law:

(7) **(per Per Rohana Yusuf PCA)** Although the trial court was right in finding that copyright subsisted in the design drawings of the appellant, the COA rightly found that no infringement of copyright had been established (see para 138).

(8) **(per Per Rohana Yusuf PCA)** The test for subsistence of copyright was not 'newness' or 'novelty' but that sufficient effort had been expended to render a work original. Hence, even if the earlier prior arts, particularly

the Prototype or Desa Kim Loong Machine were already in existence before the appellant's design drawings, the appellant's copyright still subsisted and was not negated by the existence of the earlier prior arts as provided under s 7(4) of the Copyright Act 1987. A work was not ineligible for copyright merely because the making of the work involved an infringement of copyright in some earlier or other works. What was essential for subsistence of copyright was that sufficient effort was expended in terms of time, labour and skill to render the same original (see paras 97, 103–104 & 106).

(9) **(per Per Rohana Yusuf PCA)** The COA should not have interfered with the trial court's finding that copyright subsisted in the appellant's design drawings because the respondents never challenged PW1's statutory declaration stating that he had expended sufficient effort to make his drawings original in character. This piece of evidence supported the trial court's finding that the appellant had satisfied the basic test under s 7(3)(a) of the CA to allow copyright to subsist. The trial court rightly found that the appellant had made substantive efforts to entitle itself to copyright in its design drawings (see paras 107–110).

(10) **(per Per Rohana Yusuf PCA)** To prove direct infringement of copyright, the three elements of sufficient objective similarity, substantial reproduction of the copyrighted work and causal connection between the two works had to be present cumulatively. Despite holding that the appellant had satisfied all the three elements, the trial judge failed to undertake any deliberation or analysis to show that the SK machines were a reproduction of the appellant's design drawings. There was no examination and evaluation of the distinct materials and features of both works in question or that even if the copyrighted work was copied, it amounted to a substantially significant part of the copyrighted works. The trial judge simply said there was sufficient objective similarity between the SK machines and the copyrighted works without more. There was no analysis of how the element of copying of a substantial part of the copyrighted work had taken place, no explanation of how, why and what were the similarities which constituted a substantial part of the copyrighted work. On the element of causal connection, the trial judge found there was accessibility to the design drawings when the demonstration of the FBS took place at R1's mill for two days in April 2009 and that following the demonstration, a detailed machinery layout technical drawing was sent to R1 together with the appellant's quotation. The COA, however, found no causal connection between the SK machines and the appellant's design drawings which were created in 2004. It found that the drawings that were sent with the quotation were not the alleged copyrighted works because they were dated in 2009 whereas the pleaded design drawings were that of 2004. The COA also found that DW2, the creator of the SK machines, had testified that he

was not present during the FBS demonstration. DW2 had even admitted that the SK machines were adapted from the Kim Loong drawings which were created in 2003. The Kim Loong machine was manufactured by R2 in 2003 (see paras 117–119, 123–124, 129, 131 & 133).

(11) **(per Per Rohana Yusuf PCA)** The COA was right to hold that even if there was access to the design drawings, the quotation sent to R1 was in April 2009. There was no explanation if indeed the technical drawing sent in 2009 was the same technical drawings of 2004 that formed the basis of the appellant's pleaded case. It also did not help the appellant's case when DW2 on behalf of the respondents testified that the SK machines were adapted from the Kim Loong drawings created in 2003. The COA further took into account DW2's evidence that he was not present at the demonstration to enable him to copy. The High Court did not consider this relevant piece of evidence in its judgment (see para 134).

(12) **(per Per Rohana Yusuf PCA)** To succeed in a claim for infringement, the appellant bore the burden of proving the elements of sufficient objective similarity and causal connection between the two works in order to give rise to an inference that the respondents had copied the appellant's work. The appellant had failed to establish the elements necessary to succeed in its claim for infringement. The COA rightly found that the appellant had not established that the respondents in fact had access to the appellant's design drawings (see paras 136–137).

[Bahasa Malaysia summary

Perayu memiliki paten yang difailkan pada 12 Januari 2006 untuk mesin Fruit Bunch Splitter ('FBS') yang digunakan untuk membelah buah kelapa sawit kepada kepingan yang lebih kecil supaya ia mudah diproses oleh kilang kelapa sawit. Perayu juga mendakwa ia mempunyai hak cipta dalam lukisan reka bentuk FBS dan bahagian komponennya. Pada April 2009, perayu telah memberikan demonstrasi selama dua hari mengenai operasi FBS di kilang kelapa sawit responden pertama dengan tujuan untuk mendapatkan jualan tetapi responden pertama ('R1') mendapati mesin tersebut terlalu mahal untuk dibeli. Dua tahun kemudian, perayu mendapati bahawa R1 telah mengendalikan dua mesin di kilangnya yang hampir menyerupai FBS dan mesin tersebut ('mesin SK') dibeli daripada responden kedua ('R2') yang menjalankan perniagaan , antara lain, membuat pelbagai jenis jentera untuk kilang termasuk kilang kelapa sawit. R1 telah membeli mesin SK pertama pada September 2009 dan yang kedua pada Januari 2010. Dengan mendakwa mesin SK tersebut telah menggunakan karya dan spesifikasi dalam patennya, perayu menyaman responden di Mahkamah Tinggi kerana melanggar paten dan hak cipta. Responden menafikan dakwaan tersebut dan membuat tuntutan balas untuk membatalkan paten perayu atas alasan bahawa: (a) karya yang dipatenkan tersebut bukan novel kerana karya terdahulu wujud atau telah

didedahkan kepada umum sebelum paten difailkan pada 12 Januari 2006; dan (b) karya yang dipatenkan tersebut adalah jelas dan tidak melibatkan sebarang langkah inventif. Karya terdahulu yang secara khusus diplidkan oleh responden untuk membatalkan paten adalah: (i) lukisan Mesin Kim Loong ('lukisan Kim Loong') yang dibuat pada 1 Ogos 2003; dan (ii) mesin yang terdiri daripada ciri yang sama yang terletak dan digunakan di kilang Keck Seng Bhd pada tahun 2002 ('Prototaip tersebut'). Semasa perbicaraan, responden memohon untuk meminda pliding mereka untuk memplidkan satu lagi karya terdahulu dalam bentuk 'Mesin Desa Kim Loong', tetapi permohonan pindaan mereka ditolak oleh mahkamah perbicaraan dan Mahkamah Rayuan ('MR') atas rayuan. Pada akhir perbicaraan, Mahkamah Tinggi mengesahkan tuntutan perayu untuk pelanggaran paten dan hak cipta dan menolak tuntutan balas responden. Dalam membuat keputusannya, mahkamah perbicaraan tidak mempertimbangkan sebarang keterangan karya terdahulu Mesin Desa Kim Loong kerana ia tidak diplidkan. Mengenai rayuan responden, MR mengetepikan keseluruhan keputusan Mahkamah Tinggi, menolak tuntutan perayu dan membenarkan tuntutan balas responden. MR memutuskan bahawa paten perayu menjadi tidak sah oleh karya terdahulu yang wujud dalam Prototaip (yang telah diplidkan) serta Mesin Kim Loong (yang tidak diplidkan). MR mendapati pada fakta bahawa karya perayu yang dipatenkan bukanlah sesuatu yang baru atau langkah inventif tetapi jelas kepada seseorang yang biasanya mahir dalam karya yang berkaitan pada masa material. MR juga memutuskan bahawa hak cipta tidak wujud dalam lukisan reka bentuk FBS dan sekiranya ia wujud, tiada pelanggaran hak cipta. Perayu telah diberikan kebenaran untuk memfailkan rayuan semasa terhadap keputusan MR pada tujuh persoalan undang-undang, enam daripadanya berkaitan undang-undang paten manakala soalan selebihnya berkaitan undang-undang hak cipta. Antara persoalannya adalah: (A) sama ada pihak yang berhasrat untuk mencabar kebaharuan sesuatu paten dengan bergantung pada keterangan karya terdahulu dikehendaki oleh undang-undang untuk memplidkan secara khusus butir-butir karya terdahulu tersebut; (B) sama ada MR tidak sepatutnya mempertimbangkan keterangan karya terdahulu Mesin Desa Kim Loong apabila ia berada dalam rayuan interlokutori sebelum ini tidak membenarkan responden meminda rayuannya untuk memplidkan secara khusus karya terdahulu; dan (C) sama ada lukisan reka bentuk FBS layak untuk perlindungan di bawah Akta Hak Cipta 1987 sebagai karya seni.

Semasa perbicaraan, pencipta mesin SK, DW2, memberi keterangan bahawa ketika beliau melakukan kerja kontrak di kilang Keck Seng Bhd pada tahun 2002, beliau melihat sendiri operasi Prototaip tersebut yang memberi inspirasi kepadanya untuk membuat mesin serupa untuk Kim Loong pada tahun 2002/2003. Pekerja perayu, PW1, mempertikaikan keterangan DW2 dengan mengatakan beliau tidak meungkin melihat operasi Prototaip tersebut kerana ia dirahsiakan dan hanya boleh diakses oleh pekerja yang diberi kuasa oleh Keck Seng. Mahkamah perbicaraan tidak membuat sebarang dapatan mengenai konflik keterangan ini tetapi MR, selepas meneliti keterangan dalam

rekod, mendapati pada fakta bahawa terdapat pendedahan awam Prototaip tersebut kepada DW2 semasa beliau bekerja di kilang Keck Seng dan bahawa ia adalah pendedahan yang membolehkan DW2 menggunakan pengetahuan yang diperolehnya untuk membuat mesin serupa untuk Kim Loong pada 2002/2003 seperti yang disokong dalam lukisan Kim Loong.

Berkenaan dengan hak cipta, ia adalah kes perayu bahawa hak cipta wujud dalam lukisan reka bentuk FBS kerana ia dicipta oleh PW1 yang telah berusaha keras untuk menjadikan lukisan tersebut asli dalam karakter untuk melayakkannya sebagai karya seni dalam pengertian s 7(1)(c) Akta Hak Cipta 1987. Responden, bagaimanapun, menafikan bahawa sebarang hak cipta wujud atas alasan bahawa lukisan reka bentuk tersebut bukan karya asli tetapi disalin daripada lukisan reka bentuk mesin Kim Loong pada tahun 2003. Malah jika hak cipta wujud, responden berpendapat bahawa tiada pelanggaran terhadapnya kerana perayu telah gagal untuk memenuhi unsur-unsur yang diperlukan untuk mewujudkan pelanggaran hak cipta. MR telah memutuskan bahawa tiada hak cipta wujud dalam lukisan reka bentuk FBS dan bahawa kes pelanggaran hak cipta juga tidak dibuktikan.

Diputuskan, sebulat suara menolak rayuan:

Mengenai persoalan kebenaran undang-undang paten:

(1) **(oleh Azahar Mohamed HB (Malaya))** Mahkamah ini mengesahkan dapatan khusus MR pada fakta bahawa ciptaan yang menjadi subjek paten perayu bukanlah baharu disebabkan pendedahan Prototaip di Keck Seng sebelum ini dalam pengertian dan syarat s 14(2)(a) Akta Paten 1983 dan oleh itu paten perayu adalah tidak sah (lihat perenggan 78).

(2) **(oleh Azahar Mohamed HB (Malaya))** Ia adalah menjadi keperluan dalam undang-undang bagi pihak untuk memplidkan dengan khusus butir-butir karya terdahulu yang diingin untuk digunapakai bagi membatalkan paten kerana kekurangan kebaharuan atau sebaliknya. Walaupun keperluan sedemikian tidak dinyakan dalam Akta Paten 1983 dan Peraturan-Peraturan Paten 1986, isu tersebut perlu diputuskan dengan merujuk kepada Kaedah-Kaedah Mahkamah 2012, khususnya peruntukan yang mengawal prinsip am pliding dalam A 18 k 7(1) yang mana fakta material yang perlu untuk merumuskan kausa tindakan atau pembelaan yang lengkap mesti diplidkan. Dalam mempertimbangkan sama ada karya terdahulu adalah 'fakta material' yang harus diplidkan secara khusus oleh pihak yang ingin membatalkan paten kerana kekurangan kebaharuan, ia perlu diingatkan bahawa pakar sesuatu pihak dikehendaki memberikan pendapat mereka mengenai karya terdahulu yang berkaitan untuk membantu mahkamah dalam isu pembatalan paten. Kesahan paten perlu dinilai oleh mahkamah dengan bantuan pakar yang sering dirujuk sebagai 'orang yang mempunyai kemahiran biasa dalam karya' (lihat perenggan 35–36 & 42).

(3) **(oleh Azahar Mohamed HB (Malaya))** MR gagal untuk menilai bahawa responden bergantung pada item karya terdahulu untuk membatalkan paten perayu. Atas sebab itu, kepentingan memberi notis kepada perayu oleh responden berkenaan dengan Mesin Desa Kim Loong dan pliding khusus oleh responden untuk membatalkan paten perayu tidak boleh terlalu ditekankan. Pihak yang menyerang kesahihan paten harus mengkhususkan karya terdahulu yang dipersoalkan dalam pliding supaya pihak-pihak dan pakar mereka tidak terkejut tetapi datang ke perbicaraan bersedia untuk menghadapi kes yang bertujuan untuk dibuktikan terhadap mereka (lihat perenggan 37).

(4) **(oleh Azahar Mohamed HB (Malaya))** Dalam kes semasa, perayu mahupun pakarnya tidak diberi peluang untuk meneliti Mesin Desa Kim Loong dengan terperinci dan mengemukakan pendapat/laporan bertulis mereka mengenai perkara yang sama. Pengenalan Mesin Desa Kim Loong yang tidak diplidkan oleh responden (dalam bentuk CD-ROM) pada saat akhir dan keputusan MR untuk mengakui perkara yang sama sebagai keterangan telah menyebabkan perayu tidak dapat mempertahankan kesahihan paten mereka. Keputusan MR untuk menerima keterangan Mesin Desa Kim Loong dan membatalkan paten perayu berdasarkan perkara yang sama jelas prejudis dan menyebabkan ketidakadilan kepada perayu (lihat perenggan 41).

(5) **(oleh Azahar Mohamed HB (Malaya))** Memandangkan responden tidak membuat rayuan lebih lanjut selepas percubaan mereka untuk meminda rayuan mereka untuk memasukkan karya awal Mesin Desa Kim Loong telah ditolak oleh MR, perkara itu menjadi res judicata dan MR tidak boleh mengabaikan keputusannya sebelum ini mengenai perkara tersebut dan membenarkan karya terdahulu Mesin Desa Kim Loong dipertimbangkan sebagai keterangan. MR terkhilaf dalam memutuskan hakim perbicaraan terkhilaf kerana gagal mengaku sebagai keterangan dan tidak mempertimbangkan mesin Desa Kim Loong. Mahkamah perbicaraan hanya mematuhi keputusan awal MR untuk mengecualikan Mesin Desa Kim Loong daripada sebahagian karya terdahulu (lihat perenggan 49–50).

(6) **(oleh Azahar Mohamed HB (Malaya))** MR telah dengan betul memutuskan daripada keterangan yang direkodkan bahawa terdapat keterangan yang mencukupi untuk membuktikan bahawa Prototaip di Keck Seng telah didedahkan kepada orang ramai dalam pengertian s 14(2)(a) Akta Paten dan bahawa pendedahan adalah satu yang 'membolehkan'. Pada fakta, pendedahan Prototaip semasa berada di premis persendirian pihak ketiga jelas bukan tanpa kebenaran. Prototaip tersebut, seperti dapatan oleh MR, dimasukkan ke dalam dan membentuk sebahagian daripada keseluruhan proses operasi kilang di premis Keck Seng. DW2 berada di premis tersebut secara sah dan

mempunyai akses mudah tanpa had kepada Prototaip tersebut. Tiada langkah keselamatan atau keterangan sekatan untuk mengaksesnya. Juga tiada keterangan kewajipan kerahsiaan. DW2 bebas dari segi undang-undang dan ekuiti untuk memeriksa dan menggunakan maklumat yang didedahkan oleh Prototaip tersebut. Pada fakta, mahkamah ini tidak dapat bersetuju dengan perayu bahawa Prototaip di Keck Seng telah dipasang secara sulit atau persendirian (lihat perenggan 65).

Mengenai persoalan kebenaran tunggal berkenaan undang-undang hak cipta:

(7) **(oleh Rohana Yusuf PMR)** Walaupun mahkamah perbicaraan telah dengan tepat dalam dapatan bahawa hak cipta wujud dalam lukisan reka bentuk perayu, MR betul-betul mendapati bahawa tiada pelanggaran hak cipta telah diwujudkan (lihat perenggan 138).

(8) **(oleh Rohana Yusuf PMR)** Ujian untuk mengekalkan hak cipta bukanlah 'baru' atau 'kebaharuan' tetapi usaha yang mencukupi telah digunakan untuk menjadikannya karya asli. Oleh itu, walaupun karya terdahulu, khususnya Prototaip atau Mesin Desa Kim Loong telah pun wujud sebelum lukisan reka bentuk perayu, hak cipta perayu masih wujud dan tidak dinafikan oleh kewujudan karya terdahulu terdahulu seperti yang diperuntukkan di bawah s 7(4) Akta Hak Cipta 1987. Sesuatu karya tidak layak mendapat hak cipta semata-mata kerana pembuatan karya tersebut melibatkan pelanggaran hak cipta dalam beberapa karya terdahulu atau lain-lain. Apa yang penting untuk mengekalkan hak cipta adalah usaha yang mencukupi telah digunakan dari segi masa, tenaga kerja dan kemahiran untuk menghasilkannya sebagai asli (lihat perenggan 97, 103–104 & 106).

(9) **(oleh Rohana Yusuf PMR)** MR sepatutnya tidak mengganggu keputusan mahkamah perbicaraan bahawa hak cipta wujud dalam lukisan reka bentuk perayu kerana responden tidak pernah mencabar akuan berkanun PW1 yang menyatakan bahawa beliau telah berusaha secukupnya untuk menjadikan lukisannya asli dalam karakter. Keteranagn ini menyokong keputusan mahkamah perbicaraan bahawa perayu telah memenuhi ujian asas di bawah s 7(3)(a) CA untuk membenarkan hak cipta wujud. Mahkamah perbicaraan telah dengan tepat mendapati bahawa perayu telah membuat usaha substantif untuk melayakkan dirinya bagi hak cipta dalam lukisan reka bentuknya (lihat perenggan 107–110).

(10) **(oleh Rohana Yusuf PMR)** Untuk membuktikan pelanggaran hak cipta secara langsung, ketiga-tiga elemen persamaan objektif yang mencukupi, pengeluaran semula yang banyak bagi karya berhak cipta dan hubungan sebab akibat antara kedua-dua karya tersebut perlu dikemukakan secara kumulatif. Walaupun memutuskan bahawa perayu telah berpuas hati dengan ketiga-tiga elemen tersebut, hakim perbicaraan gagal

menjalankan sebarang pertimbangan atau analisis untuk menunjukkan bahawa mesin SK adalah pengeluaran semula lukisan reka bentuk perayu. Tiada pemeriksaan dan penilaian terhadap bahan dan ciri yang berbeza bagi kedua-dua karya yang dipersoalkan atau walaupun karya berhak cipta tersebut disalin, ia terjumlah kepada sebahagian besar daripada karya berhak cipta tersebut. Hakim perbicaraan hanya menyatakan terdapat persamaan objektif yang mencukupi antara mesin SK dan karya berhak cipta tanpa lebih. Tiada analisis tentang bagaimana unsur penyalinan sebahagian besar karya berhak cipta telah berlaku, tiada penjelasan tentang bagaimana, mengapa dan apakah persamaan yang membentuk sebahagian besar karya berhak cipta tersebut. Mengenai unsur hubungan sebab akibat, hakim perbicaraan mendapati terdapat kebolehcapaian kepada lukisan reka bentuk apabila demonstrasi FBS dibuat di kilang R1 selama dua hari pada April 2009 dan berikutan demonstrasi tersebut, lukisan teknikal susun atur jentera secara terperinci telah dihantar ke R1 berserta sebut harga perayu. MR bagaimanapun mendapati tiada hubungan sebab akibat antara mesin SK dan lukisan reka bentuk perayu yang dicipta pada tahun 2004. Ia mendapati lukisan yang dihantar bersama sebut harga bukanlah karya berhak cipta yang didakwa kerana bertarikh pada 2009 sedangkan pemohon lukisan reka bentuk adalah pada tahun 2004. MR juga mendapati bahawa DW2, pencipta mesin SK, telah memberi keterangan bahawa beliau tidak hadir semasa demonstrasi FBS. DW2 telah pun mengakui bahawa mesin SK telah diadaptasi daripada lukisan Kim Loong yang dicipta pada tahun 2003. Mesin Kim Loong telah dikeluarkan oleh R2 pada tahun 2003 (lihat perenggan 117–119, 123–124, 129, 131 & 133).

(11) **(oleh Rohana Yusuf PMR)** MR adalah tepat dalam memutuskan bahawa walaupun terdapat akses kepada lukisan reka bentuk, sebut harga yang dihantar kepada R1 adalah pada April 2009. Tidak ada penjelasan jika lukisan teknikal yang dihantar pada 2009 adalah lukisan teknikal yang sama pada 2004 yang menjadi asas kepada kes yang diplidkan perayu. Ia juga tidak membantu kes perayu apabila DW2 bagi pihak responden memberi keterangan bahawa mesin SK telah diadaptasi daripada lukisan Kim Loong yang dicipta pada tahun 2003. MR seterusnya mengambil kira keterangan DW2 bahawa beliau tidak hadir pada demonstrasi untuk membolehkannya untuk menyalin. Mahkamah Tinggi tidak mempertimbangkan keterangan yang relevan ini dalam penghakimannya (lihat perenggan 134).

(12) **(oleh Rohana Yusuf PMR)** Untuk berjaya tuntutan pelanggaran, perayu menggalas beban membuktikan unsur persamaan objektif yang mencukupi dan hubungan sebab akibat antara kedua-dua karya untuk membnagkitkan inferens bahawa responden telah menyalin kerja perayu. Perayu telah gagal untuk membuktikan unsur-unsur yang diperlukan untuk berjaya tuntutannya bagi pelanggaran. MR betul-betul mendapati

bahawa perayu tidak membuktikan bahawa responden sebenarnya mempunyai akses kepada lukisan reka bentuk perayu (lihat perenggan 136–137).]

Cases referred to

Alsop Flour Process Ltd v Flour Oxidizing Co Ltd, Re Andrews' Patent (1908) 25 RPC 477, HL (refd)
B Braun Melsungen AG & Anor v Terumo Kabushiki Kaisha & Anor [2011] 6 AMR 101, HC (refd)
Bristol-Meyer Co's Application [1969] RPC 146 (refd)
Bruce v Odhams Press Ltd [1936] 1 All ER 287, CA (refd)
CIMB Bank Berhad v Sebang Gemilang Sdn Bhd & Anor [2015] MLJU 2148, CA (refd)
Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor [2015] 3 MLJ 1, FC (refd)
Elster Metering Limited & Anor v Damini Corporation Sdn Bhd & Anor [2012] MLJU 1753, CA (refd)
Folding Attic Stairs Ltd v Loft Stairs Co Ltd [2009] EWHC 1221 (Pat) (refd)
Francis Day & Hunter Ltd and another v Bron and another [1963] Ch 587, CA (refd)
Genelabs Diagnostics Pte Ltd v Institut Pasteur & Anor [2001] 1 SLR 121, CA (refd)
Generics (UK) Ltd and others v H Lundbeck A/S [2009] 2 All ER 955, HL (refd)
Government of Malaysia v Dato Chong Kok Lim [1973] 2 MLJ 74 (refd)
Hartecon JV Sdn Bhd & Anor v Hartela Contractors Ltd [1996] 2 MLJ 57, CA (refd)
Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor (Registrar of Trade Marks, intervener) [2015] 4 MLJ 166, FC (refd)
Holliday v Heppenstall Bros (1889) 6 RPC 320, CA (refd)
Kirin-Amgen Inc and others v Hoechst Marion Roussel Ltd and others; Hoechst Marion Roussel Ltd and others v Kirin-Amgen and others [2005] 1 All ER 667, HL (refd)
Lau Foo Sun v Government of Malaysia [1974] 1 MLJ 28, FC (refd)
Longman Malaysia Sdn Bhd v Pustaka Delta Pelajaran Sdn Bhd [1987] 2 MLJ 359 (refd)
Lubrizol Corpn v Esso Petroleum Co Ltd [1998] RPC 727, CA (refd)
Lux Traffic Controls Ltd v Pike Signals Ltd [1993] RPC 107, Ch D (refd)
Megnaway Enterprise Sdn Bhd v Soon Lian Hock (sole proprietor of the firm Performance Audio & Car Accessories Enterprise) [2009] 3 MLJ 525, HC (refd)
Merck Sharp & Dohme Corp & Anor v Hovid Bhd [2019] 12 MLJ 66, FC (refd)
Merck Sharp & Dohme Corp & Anor v Hovid Bhd [2017] MLJU 77; [2017] 1 LNS 53, HC (refd)
Mohd Syamsul bin Md Yusof & Ors v Elias bin Idris [2019] 4 MLJ 788, FC (folld)

Ong Leong Chiou & Anor v Keller (M) Sdn Bhd & Ors [2021] 3 MLJ 622, FC (refd)
PLG Research Ltd v Ardon International Ltd [1993] FSR 197 (refd)
Pall Corp v Commercial Hydraulics (Bedford) Ltd [1990] FSR 329 (refd)
Palm Oil Research and Development Board Malaysia & Anor v Premium Vegetable Oils Sdn Bhd & another appeal [2005] 3 MLJ 97, FC (refd)
Purefoy Engineering Co Ltd v Sykes Boxall & Co Ltd, Sykes and Boxall (1955) 72 RPC 89, CA (refd)
Quantel Ltd v Spaceward Microsystems Ltd [1990] RPC 83, Ch D (refd)
Radion Trading Sdn Bhd v Sin Besteam Equipment Sdn Bhd & Ors [2010] 9 MLJ 648, HC (refd)
Ranbaxy (Malaysia) Sdn Bhd v EI Du Pont De Nemours & Co [2011] MLJU 1135; [2011] 1 AMCR 857, HC (refd)
Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Anor [2018] 4 MLJ 34, FC (refd)
Stanway Oyster Cylinders Pty Ltd v Marks (1996) 144 ALR 627, FC (refd)
The General Tire & Rubber Company v The Firestone Tyre and Rubber Company Limited and others [1972] RPC 457, CA (refd)
University Of London Press, Limited v University Tutorial Press, Limited [1916] 2 Ch 601, Ch D (refd)
Venu Nair & Anor v Public Bank Bhd [2017] 5 MLJ 529, CA (refd)

Legislation referred to

Rules of Court 2012 O 18 r 7(1)
Copyright Act 1987 ss 3, 7, 7(1), (1)(c), (2), (2A), (3), (3)(a), (4), 13(1), 36, 42
Patents Regulations 1986
Patents Act 1983 s 14, 14(1), (2), (2)(a)

Appeal from: *Sungei Kahang Palm Oil Sdn Bhd & Anor v YKL Engineering Sdn Bhd* [2020] MLJU 953 (Court of Appeal, Putrajaya)

Cyrus Das (with Teo Bong Kwang and Eugene Ee Fu Xiang) (Wong Jin Nee & Teo) for the appellant.
Ambiga Sreenevasan (with Ken St James, Janini Rajeswaran, Desmond Louis, Sarah Ho Yixin, Jonathan Gerard and Anishaa Sundramoorthy) (Ken St James) for the respondents.

Azahar Mohamed CJ (Malaya) (delivering judgment of the court):

INTRODUCTION

[1] This is an appeal against the decision of the Court of Appeal which reversed the High Court's decision that allowed the appellant's claim for patent and copyright infringements against the respondents.

[2] The appellant's claims revolve around its Malaysian Patent No MY139512-A relating to a machine used in the oil palm industry known as the 'fruit bunch splitter' ('fruit bunch splitter') ('the appellant's patent') and the design drawings relating to the fruit bunch splitter and its component parts ('design drawings'). A

[3] The appellant sued both the respondents at the High Court for infringement of the appellant's patent and infringement of copyright subsisting in the design drawings of the fruit bunch splitter. B

[4] The High Court found in favour of the appellant and held that the respondents had infringed the appellant's patent and the copyright subsisting in the design drawings of the fruit bunch splitter. C

[5] The Court of Appeal took a diametrically opposite view. The Court of Appeal in effect found that the appellant's patent was invalid, copyright did not subsist in the design drawing of the fruit bunch splitter, and that in any event, there was no infringement of copyright. D

[6] After hearing the parties, we adjourned the matter for our deliberation. We now give our decision and the grounds for the same. I will only deal with the questions relating to patent law. The question concerning copyright law will be dealt with in this judgment by our learned sister, Rohana Yusuf PCA. E

THE PARTIES F

[7] The appellant is a company incorporated in Malaysia and is in the business of designing and manufacturing specialised machinery and equipment for palm oil processing. The appellant is the registered proprietor of the appellant's patent which was filed on 12 January 2006 and subsequently granted on 30 October 2009. The appellant's patent has been duly renewed and is therefore valid and subsisting at all material times. G

[8] The first respondent is a company incorporated in Malaysia and is in the business of operating a palm oil factory including processing fresh fruit bunches ('FFB') of palm oil. The first respondent has been in the palm oil milling business since 1994. H

[9] The second respondent is a company incorporated in Malaysia and is in the business of manufacturing, servicing and trouble-shooting technical and other related issues concerning machineries in plant construction for palm oil mills, wood and pulp processing and industrial plants and companies since 1988. I

THE PATENT

[10] The invention relates to a machine that reduces the size of palm oil FFB by splitting them into smaller pieces.

[11] In the 'Background of the Invention', the appellant's patent describes the prior art of the comprising apparatus or machines where the palm oil FFB are either wholly inserted into the sterilising process or manually cut into smaller pieces. This apparently increased the cooking time or slowed down the processing whilst the manual cutting required a large amount of labour. The invention is said to address this problem by providing a machine that can reduce the size of the FFB before they are sterilised. The invention also apparently provides a convenient means of collecting the FFB after the splitting.

[12] In the 'Abstract', the subject matter of the appellant's patent is stated as an apparatus for splitting palm oil and other fruit bunches comprising two parallel, inward and oppositely revolving drums which are fitted with sharp spikes in order to split large fruit bunches, wherein the drums are rotated by a high torque motor and are capable of splitting fruit bunches upwards of 60kg and where the split fruit bunches fall to a collecting receptacle on the underside of the splitter housing.

[13] There are 12 claims in the patent, of which claim 1 is independent whilst the remaining eleven claims (claims 2–12) are ultimately dependent on claim 1.

FACTUAL BACKGROUND

[14] On or about 15 April 2009, the appellant approached the first respondent to showcase its fruit bunch splitter. On 24 April 2009, the appellant installed its fruit bunch splitter at the first respondent's premises for test run purposes and to conduct a demonstration with a view to a sale. The appellant provided a quotation for the sale of the fruit bunch splitter. The sale was however, not concluded despite numerous follow-ups by the appellant. Evidently, the first respondent viewed it as too costly.

[15] The dispute between the parties arose on or about 15 April 2011 when the appellant received information that the pt respondent had been operating two units of oil palm fruit bunch splitters in its factory which closely resembled its fruit bunch splitter. Upon visiting the pt respondent's premises, the appellant found that the first respondent had indeed installed two units of oil palm fruit bunch splitters. As it turned out, the first respondent purchased the two units from the second respondent ('the SK Machines'). The first SK

Machine was purchased in September 2009 whilst the second was purchased in January 2010. The appellant claimed that both the SK Machines were made in accordance with the invention disclosed and claimed in the specifications of the appellant's patent.

THE HIGH COURT PROCEEDINGS

[16] Subsequently, the appellant sued both the respondents for infringement of its patent and copyright in respect of the manufacturing and the use of the SK Machines. In substance, the appellant's case is that the second respondent infringed the appellant's patent by manufacturing and selling two units of the SK Machines to the first respondent and that the first respondent had infringed the appellant's patent by using the SK Machines.

[17] The respondents denied the allegations of patent infringement and counterclaimed to invalidate the patent for:

(a) lack of novelty, by virtue of the prior art which was disclosed to the public prior to the filing date of the appellant's patent (12 January 2006); and/or

(b) obviousness, as having regard to the prior art and common general knowledge, the invention which was the subject matter of the appellant's patent did not involve an inventive step.

[18] The prior art which was specifically pleaded by the respondents, among others are:

(a) drawings of the Kim Loong Machine ('Kim Loong drawing') created on 1 August 2003; and

(b) a machine comprising the same features located and operating at Keck Seng Bhd in 2002 ('the prototype/machine at Keck Seng').

[19] During the trial of the action, specifically after the appellant's case had closed and its experts had been released, the respondents sought leave to re-amend their amended defence and counterclaim which had already been amended once pursuant to the Court of Appeal's order dated 25 June 2013 to introduce an additional prior art in the form of an alleged prior use of a machine known as the 'Desa Kim Loong Machine'.

[20] The said application was dismissed by the High Court, whose decision was affirmed on appeal by the Court of Appeal. In point of fact, the Desa Kim Loong Machine was therefore not a pleaded prior art.

A DECISION OF THE HIGH COURT

[21] As we have alluded to earlier, the High Court found in favour of the appellant and concluded that the respondents had infringed the appellant's patent. Accordingly, the High Court dismissed the respondents' counterclaims.

[22] In considering the issue of novelty, the High Court rejected the evidence relating to the Desa Kim Loong Machine as a prior art as it was not a pleaded prior art and could not be legally admitted for consideration as one of the prior arts to challenge the validity of the appellant's patent.

[23] On the issue of lack of inventive step, the High Court made a finding that the appellant's patent is inventive and not obvious to persons skilled in the art at the material time.

DECISION OF THE COURT OF APPEAL

[24] The Court of Appeal allowed the respondents' appeal and set aside the whole of the High Court's decision. For that reason, the respondents' counterclaims were allowed while the appellant's claims were dismissed. Principally, the Court of Appeal found that the appellant's patent was invalid.

[25] The appellant's patent was invalidated on the ground of anticipation by prior art due to existence of the Desa Kim Loong Machine (which was not pleaded) and the prototype/machine at Keck Seng.

[26] On the issue of inventive step, the Court of Appeal found as a fact that the purported inventive concept is obvious to the normally skilled but unimaginative addressee in the art at the priority date to whom has been imputed the common general knowledge in the relevant art.

QUESTIONS OF LAW ON APPEAL TO THE FEDERAL COURT

[27] This court granted leave to the appellant to appeal against the decision of the Court of Appeal on the following questions of law:

(1) where a defendant invokes s 14(2)(a) of the Patents Act 1983 ('the Act') to raise the issue of anticipation by prior art to dispute the novelty of the plaintiff's patent, whether the defendant is obliged by law to plead with specificity the particulars of prior art relied upon by him to defeat the registered patent?

(2) in a patent trial where anticipation is raised to challenge the validity of a patent, whether a defendant should be allowed to rely on prior art documents and/or prior use which were not specifically pleaded in its attempt to invalidate the patent? A

(3) whether a patent appeal had miscarried where the appellate court had disregarded a prior decision of the appeal court itself in the same case to disallow reliance on an item of alleged prior art which the High Court had loyally followed subsequently by disregarding the said item in arriving at its decision? B

(4) can s 14(2)(a) of the Act on public disclosure of a prior art apply where there has been an unauthorised disclosure to a third party of the prototype of the machine invented by the plaintiff? C

(5) whether a defendant could invalidate a patent on the ground of anticipation pursuant to s 14(2)(a) of the Act where it is a case of an unauthorised disclosure of the plaintiff's prototype machine installed on a private property for experimentation by the plaintiff? D

(6) if claim 1 of a patent is declared to be invalid, is there a legal duty for the court to examine each and every dependent claim and decide individually whether the dependent claim is valid and thereafter to decide whether any of the dependent claims has been infringed? and E

(7) having regard to the concept of originality in copyright law which is distinct from the concept of novelty in patent law, whether the design drawings of an article (the Work) would independently be eligible for copyright protection under s 7(2), (2A) and (4) of the Copyright Act 1987 as artistic works? F

[28] Questions 1 to 6 relate to patent law. Question 7 concerns copyright law. As said earlier, I will only deal with questions relating to patent law. G

Questions 1 and 2

[29] These questions raise the issue of 'prior art', which is the basis requirement of s 14 of the Patents Act 1983 ('the PA 1983'). Both the questions H address whether a prior art relied upon to establish lack of novelty vis a vis an invention claimed in a patent must be specifically pleaded, and if not specifically pleaded, whether evidence in relation thereto may be admitted and relied upon. Questions 1 and 2 relate only to the Desa Kim Loong Machine. It bears emphasis that Desa Kim Loong Machine was not pleaded by the I respondents as an item of prior art to invalidate the appellant's patent for lack of novelty.

[30] The real point in both the questions arose from certain parts in the

Court of Appeal's ground of judgment wherein the appellant's patent was invalidated by the Court of Appeal on the ground of 'anticipation by prior art' pursuant to s 14(1) and (2)(a) of the PA 1983. The Court of Appeal held that the appellant's patent had been anticipated by the Desa Kim Loong Machine. The Court of Appeal held that the evidence relating to the Desa Kim Loong Machine (which was not pleaded) was admissible to establish the pleaded material facts as it occasioned no surprise and caused no prejudice or injustice to the appellant. The respondent had pleaded the material facts — that the invention which was the subject matter of the appellant's patent was not new (had been anticipated) and was therefore invalid. The Court of Appeal held that the appellant was not taken by surprise by the introduction of the evidence relating to the Desa Kim Loong Machine when the same was introduced well before the commencement of the trial. Evidence was also led on the same during the trial. The Court of Appeal found that the appellant suffered no surprise, prejudice or injustice.

Contentions of parties in respect of questions 1 and 2

[31] The appellant's contentions can be summarised as follows. The rules on pleadings are especially stringent in patent suit where the patent holder must be informed of the precise basis, namely the prior art relied on by the attacker to invalidate his patent. By established rule, the parties' experts would be required to provide their opinion on the relevant prior art to assist the court on the issues of invalidation and infringement of the patent. Hence, the necessity for the defendants to give notice by pleading of the relevant prior art which was relied on to invalidate the patent. It is to prevent surprise and trial by ambush. Further, where prior user in the form of a machinery is relied upon to invalidate the patent, such as the respondents' reliance on the non-pleaded Desa Kim Loong Machine in this case, the respondents must identify the prior user with sufficient particulars including the time and place of its use. The respondents must point out *in situ* the particulars of the apparatus to which he refers, and to procure it if possible, for the full inspection thereof by the appellant. The Court of Appeal's decision in admitting the Desa Kim Loong Machine and invalidating the appellant's patent based on the same had clearly prejudiced and caused injustice to the appellant.

[32] The respondents' main contentions are as follows. In Malaysia, unlike other commonwealth jurisdictions, there is no specific legal requirement that prior art must be specifically identified, pleaded and particularised. Based on the general principles of pleadings, what must be pleaded are the material facts which are facts necessary for the purpose formulating a complete cause of action or defence. When a defence of anticipation is raised, the material facts which must be pleaded to formulate a complete cause of action is that the patent is invalid by reason of the fact that the invention which is the subject of the claims lacks novelty. The prior art which establishes the said material fact is

evidence and thus, does not need to be specifically pleaded. Given that prior art (or prior use) is evidence relevant to the pleaded defence, such evidence ought to be admissible even if it is not specifically pleaded and a party ought to be allowed to rely on the same to invalidate a patent subject to of course, to the principle that no prejudice or injustice is occasioned. The respondents had pleaded the material facts — that the invention which was the subject matter of the appellant's patent was not new and was therefore invalid. On the facts here, the appellant was not taken by surprise by the introduction of the evidence and that the appellant suffered no surprise, prejudice or injustice.

Findings and Analysis in respect of questions 1 and 2

[33] These questions raise the issue of 'prior art', which is the basis requirement of s 14 of the PA 1983 which provides:

> 14 Novelty
>
> (1) An invention is new if it is not anticipated by prior art.
>
> (2) Prior art shall consist of —
>
> (a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention;
>
> (b) ...

[34] Novelty is a prerequisite for patentability. In order to consider the nature of novelty it is necessary to bear in mind the provisions of s 14 of the PA 1983. The provisions require an invention to be new in the sense that on the date of filing of patent application, it should not form a part of the state of the art. The invention is not novel if it is anticipated by prior art and prior art consists of everything disclosed to the public anywhere in the world by written publication, oral disclosure and by use or in any other way before the priority date of the patent application claiming the invention. The priority date is the date by which the novelty of the invention is to be judged. In order for any prior art to provide sufficient disclosure, the disclosure must be enabling in nature, that is to say, giving sufficient and clear instructions or teachings to arrive at the disputed invention (see *The General Tire & Rubber Company v The Firestone Tyre and Rubber Company Limited and others* [1972] RPC 457 ('General Tire & Rubber Company').

[35] Undeniably, in our jurisdiction, unlike others such as the United Kingdom, Australia and Singapore, there are no specific provisions, whether in the PA 1983 and the Patents Regulations 1986 that require a party to plead with specificity the prior art a party intends to rely on to invalidate a patent for lack of novelty or otherwise. The questions therefore fall to be decided by reference to the Rules of Court 2012 ('the ROC 2012'). The order of the ROC

2012 which governs the general principles of pleadings is O 18 r 7(1). This rule lays down the requirements of the pleading, namely that pleadings should be statements in summary form, stating only the material facts in a manner which is brief and to the point, and not the evidence by which they are to be proved (see *Malaysian Civil Procedure 2021* (Sweet & Maxwell, Vol 1) para 18/7/1). Material facts are facts which are necessary for the purpose of formulating a complete cause of action and for establishing a defendant's defence (see *Bruce v Odhams Press Ltd* [1936] 1 All ER 287).

[36] The question than arises: is a prior art a 'material fact' that must be pleaded with specificity by a party seeking to invalidate a patent for lack of novelty? In addressing this question, it is important to note that in a case where a party claims that a patent is not a patentable invention as it is not new and does not involve an inventive step, the parties' expert is required to provide their opinion on the relevant prior art to assist the court on the issues of invalidation of the patent. Validity of the patent must be assessed by the court with the aid of an expert often referred to as a 'person having ordinary skill in the art' (see *Spind Malaysia Sdn Bhd v Justrade Marketing Sdn Bhd & Anor* [2018] 4 MLJ 34 (FC) ('Spind Malaysia Sdn Bhd')). More often than not, patent litigations involved technical and complex construction of the patent itself and its specifications. The court is informed by the expert as to the meaning of technical words and phrases and what was at the relevant time, the common general knowledge as possessed by the notional skilled man or an appropriately skilled addressee (see *General Tire & Rubber Company* and *Kirin-Amgen Inc and others v Hoechst Marion Roussel Ltd and others; Hoechst Marion Roussel Ltd and others v Kirin-Amgen and others* [2005] 1 All ER 667). As explained by Adous J in the case of *Lubrizol Corpn v Esso Petroleum Co Ltd* [1998] RPC 727:

> Patent specifications (description) are intended to be read by persons skilled in the relevant art, but their construction is for the court. Thus, the court must adopt the mantle of the notional skilled addressee and determine, from the language used, what the notional skilled addressee would understand to be the ambit of the claim. To do that it is often necessary for the court to be informed as to the meaning of technical words and phrases and what was, at the relevant lime, the common knowledge; the knowledge that the notional skilled man would have.

[37] In our judgment, the Court of Appeal failed to appreciate that this was a patent case and that the respondents were relying on items of prior art with the object of invalidating the appellant's patent. For this reason, the importance of giving notice to the appellant by the respondents in respect of the Desa Kim Loong Machine and of specific pleading by the respondents seeking to invalidate the appellant's patent can never be overemphasised. A party attacking the validity of a patent should particularise the prior art in question

in the pleading so that the parties and their experts may come to the trial prepared to meet the case which is intended to be proved against them, and that there may be no taking by surprise (see *Holliday v Heppenstall Bros* (1889) 6 RPC 320).

[38] In *Alsop Flour Process Ltd v Flour Oxidizing Co Ltd, Re Andrews' Patent* (1908) 25 RPC 477, the House of Lords refused to consider a non-pleaded prior art given the danger and unfairness that may occasion if it were to do so. Lord Loreburn observed as follows:

> I find that this Objection was not mentioned in the Particulars, and that though a few questions were put in cross-examination of the Patentees' witnesses relating to the point, no notice was given of the purpose for which they were put, no amendment asked or granted at the trial, no such Objection made when Petitioners opened their case at the trial, and it was only in the Petitioners' reply that the point was raised. Few things could be more dangerous or unfair than to admit now, in a case so complicated and full of details, an Objection which has such a history For these reasons I must decline to entertain it.

[39] Learned counsel for the appellant brought to our attention two High Court cases, namely *B Braun Melsungen AG & Anor v Terumo Kabushiki Kaisha & Anor* [2011] 6 AMR 101 and *Ranbaxy (Malaysia) Sdn Bhd v EI Du Pont De Nemours & Co* [2011] MLJU 1135; [2011] 1 AMCR 857. Essentially, these cases have likewise required a party seeking to invalidate a patent on lack of novelty to plead and particularise all the relevant prior art relied on with specificity as a matter of practice and prudence. The approach taken by these High Court cases is in accord with the principles derived from the cases that we have discussed earlier.

[40] Our attention was then drawn by learned counsel for the respondents to the case *Merck Sharp & Dohme Corp & Anor v Hovid Bhd* [2017] MLJU 77; [2017] 1 LNS 53 where the High Court took a different approach. The plaintiff in that case objected to the defendant's reliance of two prior publications which had not been pleaded. The High Court dismissed the objection, among others, on the ground that it was clear from the amended defence and counterclaim where the words 'inter alia' were used that the publications pleaded as prior art were not exhaustive. We agree with the arguments of learned counsel for the appellant that the above approach in relying on qualifications such as 'inter alia' and 'limited to', which is similarly adopted by the Court of Appeal in the present case, are unprecedented in patent litigation as it is contrary to the basic principle of a full disclosure to prevent any surprise during the patent trial and to afford the plaintiff, particularly its experts, with the opportunity to deal with all the prior art relied on by the defendant.

[41] In the present case, neither the appellant nor its experts were afforded the opportunity to scrutinise the Desa Kim Loong Machine in great detail and to submit their written opinions/reports on the same, as is the case in every patent trial. The respondents' introduction of the non-pleaded Desa Kim Loong Machine (in the form of a CD-ROM) at the eleventh hour and the Court of Appeal's decision to admit the same into evidence had handicapped the appellant in its defence of their patent's validity. In this way, the Court of Appeal's decision in admitting the Desa Kim Loong Machine and invalidating the appellant's patent based on the same had clearly prejudiced and caused injustice to the appellant.

[42] Based on all the above reasoning, we conclude that it is a requirement in law on the part of a party to plead with specificity the particulars of prior art a party intends to rely on to invalidate a patent for lack of novelty or otherwise. We therefore answer questions 1 and 2 in favour of the appellant. Hence, question 1 should be answered in the affirmative and question 2 should be answered in the negative.

Question 3

[43] Question 3 addresses the issue whether the appeal has miscarried when the Court of Appeal disregards its earlier decision of 'disallowing reliance on an alleged prior art'.

[44] A point to note is that question 3 arises by reason of the appellant's objections, during the trial of the action, to the admissibility of the Desa Kim Loong Machine on the ground that the said prior art was not pleaded. The appellant applied for leave to amend the defence and counterclaim to specifically plead the Desa Kim Loong Machine. The appellant objected to the same and the application was dismissed by the High Court. The respondents appealed to the Court of Appeal and the Court of Appeal upheld the High Court's decision. There was no further appeal by the respondents to the Federal Court. Despite the Court of Appeal's earlier decision in dismissing the respondents' application to re-amend their pleadings, the Court of Appeal in the present matter had admitted and relied on the non-pleaded Desa Kim Loong Machine as a prior art against the patent.

[45] The question then arises: can the Court of Appeal rely on an item of prior art rejected by a previous decision of another panel of the Court of Appeal in the same case?

Contentions of parties in respect of question 3

[46] The appellant contended that by disregarding its previous decision on the same issue (which ought to be treated as final and binding upon the parties) and allowing the Desa Kim Loong Machine to be admitted, the Court of Appeal had contravened the principle of res judicata and had seriously prejudiced the appellant.

[47] On the other hand, the respondents contended question 3 is premised on the incorrect assumption that: (a) all prior art must be specifically pleaded; and (b) the earlier decision of the Court of Appeal necessarily equates to the Court of Appeal having previously 'disallowed reliance on an item of alleged prior art'. The Court of Appeal did not set aside or reverse; ignore or disregard the earlier decision or order of the Court of Appeal and the issue of res judicata or whether the appeal had miscarried does not arise on the facts here. The Court of Appeal merely reversed a ruling on the admissibility of the evidence relating to the Desa Kim Loong Machine (which was relevant to the pleaded defence of anticipation) which it is entitled to do.

Findings and analysis on question 3

[48] It has to be noted that this question flows from the earlier two questions. For this reason, the contentions by the respondents are clearly untenable in light of our decision that a specific prior art must be pleaded if a party intends to rely on it to invalidate a patent for lack of novelty or otherwise.

[49] Even more to the point is that, since there was no appeal to the Federal Court against the earlier dismissal of the respondents' amendment application, the decisions of the High Court and the earlier Court of Appeal pertaining to the treatment of the non-pleaded Desa Kim Loong Machine becomes final and could not be re-opened by the present Court of Appeal at a later stage during the appeal proper. By disregarding its previous decision on the same issue (which ought to be treated as final and binding upon the parties) and allowing the Desa Kim Loong Machine to be admitted, the Court of Appeal had contravened the principle of res judicata. The principle of res judicata is based on the need of giving a finality to judicial decisions. Once a res is judicata, it shall be not adjudged again (see *Government of Malaysia v Dato Chong Kok Lim* [1973] 2 MLJ 74 (HC), *Venu Nair & Anor v Public Bank Bhd* [2017] 5 MLJ 529 (CA) and *CIMB Bank Berhad v Sebang Gemilang Sdn Bhd & Anor* [2015] MLJU 2148 (HC)). It does not matter that the earlier decision was made at the interlocutory stage; it is nevertheless binding on the parties and the Court of Appeal. A decision given by a court at one stage on a particular matter or issue is binding on it at a later stage in the same suit or in a subsequent suit (see *Hartecon JV Sdn Bhd & Anor v Hartela Contractors Ltd* [1996] 2 MLJ

57 (CA)). The Court of Appeal could not rely on an item of prior art rejected by a previous decision of the Court of Appeal itself in the same case. There is nothing in the Court of Appeal's judgment to indicate that its earlier decision was set aside or disregarded on the basis of illegality or lack of jurisdiction. Instead, the court found that:

> [126] ... At the trial, the appellants sought to amend their pleadings to include the Desa Kim Loong Machine as another prior art. The amendment was refused and the decision affirmed on appeal. There are no grounds available and we loathe to speculate on the reasons for the refusal.

[50] The Court of Appeal therefore erred in holding that 'the learned judge was in error in failing to admit into evidence and also in not considering the Desa Kim Loong Machine as one of the several prior arts' given that the High Court at the trial was only following the earlier Court of Appeal's decision, as it is bound to, in excluding the Desa Kim Loong Machine from the body of prior art.

[51] In the circumstances, question 3 must be answered in the affirmative.

Questions 4 and 5

[52] We come now to the more delicate and difficult questions which raise the issue of the scope of the 'public disclosure' requirement under s 14(2)(a) of the PA 1983 to invalidate a registered patent. Questions 4 and 5 relate only to the prototype/machine at Keck Seng.

[53] It is important to emphasise the prior art which was specifically pleaded by the respondents in the amended defence and counterclaim and amended rejoinder and reply to defence counterclaim is the prototype/machine at Keck Seng located and operating at Keck Seng Bhd in 2002.

[54] Questions 4 and 5 arise by reasons of the following background facts. At trial, Tan Tiam Poh ('DW2') who invented the SK Machines testified that he had himself seen the prototype/machine at Keck Seng prior to the priority date when he was carrying out contract work for Keck Seng in 2002. DW2 told the court that he had easy unrestricted access to the prototype and that any contractor on Keck Seng's premises could see the prototype without any prohibition. In short, the respondents' case was that there had been prior disclosure of the prototype and thereby the fruit bunch splitter.

[55] On the other hand, Yeo Koon Lean ('PW1') had testified that the prototype was kept a secret at all material times of experimentation where the respondents including DW2 would never have been allowed or authorised to view the prototype. The second respondent or its workmen were only

authorised access to the area earmarked for the lipofrac plant which the second respondent was appointed by Keck Seng to construct. PW1 explained that the prototype was kept on a raised platform and covered by a roof where only the authorised employees of Keck Seng would have had access to it. Access was also restricted because a lot of research and development was carried out at Keck Seng's premises located on private property. As a public listed company, Keck Seng had a policy on secrecy and confidentiality and its effect on the company's reputation and thus could not allow anyone to enter freely and put the company at risk if anything happened to the visitor.

[56] The above conflicting evidence brings into question the issue whether the prototype of a patented machine, which is kept on private property for testing purposes, could be a public disclosure within the meaning of s 14(2)(a) of the PA 1983. This critical issue was however not dealt with at all by the High Court despite the parties had pleaded, led to the evidence and extensively addressed the issue. The High Court had failed to consider that the prototype was disclosed to the public and to the palm oil industry prior to the filing date of the appellant's patent.

[57] The Court of Appeal carefully examined and comprehensively evaluated the evidence relating to the prototype and found as a fact that the prototype had been disclosed to DW2, who was lawfully on Keck Seng's premises, had unrestricted access to the prototype and was free in law and equity to examine and use the information disclosed by the prototype. The Court of Appeal also found as a fact that the disclosure was an enabling disclosure and the prototype had therefore been disclosed to the public within the meaning of s 14(2)(a) of the PA 1983.

Contentions of parties in respect of questions 4 and 5

[58] In the main, the appellant contended that the crucial requirement under s 14(2)(a) of the PA 1983 is that the disclosure must be a 'public' disclosure or a 'disclosure to the public'. It follows that a private 'disclosure' or a prototype model installed at private premises for testing purposes of experimentation is not within its ambit. The alleged prior art in question here is the prototype unit of the fruit bunch splitter which was installed by the appellant at the premises of Keck Seng for private experimentation purposes. Furthermore, the Court of Appeal failed to appreciate that given the prototype was covered by metal coverings or plates on all sides, which made it not possible for anyone to view its parts and workings, the prototype did not satisfy the 'enabling disclosure' test which requires the essential features or integers of the invention to be disclosed to the public that would enable the public to re-create the invention, before it can be regarded as a prior art that anticipated the patent. The Court of Appeal also failed to appreciate the well-established

position in other jurisdictions that the experimentation of an invention's prototype in a public setting (even without any express or implied obligation of secrecy on the bystander) does not automatically mean that the patented invention has been disclosed to the public and be regarded as an item of prior art.

[59] The main contentions of the respondents are as follows. Both questions 4 and 5 are premised entirely on the purported 'fact' that the disclosure of the prototype/machine at Keck Seng was 'unauthorised'. This is an incorrect assumption of fact and is in direct contradiction of the findings of fact by the Court of Appeal. With regard to what amounts to a 'disclosure to the public' where information (whether in documentary form or in the form of the invention itself) has been communicated or made available to at least one member of the public who is free in law and equity to use it, (and that disclosure is an enabling disclosure) that information has been disclosed to the public and forms the prior art. There is no need to prove that anybody saw the prior art, provided that the relevant disclosure was in public. Where such information is communicated under the obligation of confidence, it follows that the recipient will not be free in law or equity to use it. Disclosure under such circumstances will not amount to disclosure to the public. This principle applies equally to prototype. If the prototype was however installed on a private property such private factory premises, whether for experimentation or otherwise, whether there is disclosure to the public will depend on the facts of the case. The Court of Appeal found as a fact the prototype/machine at Keck Seng had been disclosed to the public within the meaning of s 14(2)(a) of the PA 1983 and that the disclosure was an enabling disclosure.

Findings and analysis on questions 4 and 5

[60] As seen earlier, by virtue of s 14(1) of the PA 1983 an invention is new if it is not anticipated by prior art. 'Prior art' is defined in s 14(2) of the PA 1983 as consisting of:

> (a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or any other way, prior to the priority date of the patent application claiming the invention;

[61] In other words, an invention can only be validly treated as a patentable invention if it is new or novel and has never been disclosed to the public in the sense set out in s 14(2)(a) of the PA 1983.

[62] In deliberating these questions, we note that the contentions of the appellant are not free from difficulties. In the first place, as argued by learned counsel for the respondents, both questions 4 and 5 are premised on the purported 'fact' that the disclosure of the prototype was 'unauthorised'. In this

context, we have, with care, read the grounds of judgment of the Court of Appeal. The Court of Appeal extensively examined and evaluated the evidence relating to the prototype/machine at Keck Seng (which the High Court had failed to do) and made, among others, the following findings of fact:

At para 172:

> [172] According to the respondent, there can be no disclosure due to the confidentiality, privacy and secrecy. On that issue, we find those conditions actually not established.

At paras 176–177 and 179:

> [176] From the evidence, we find none of the requirements met. It is wrong in law to impose any such relationship, even in equity, between the second appellant and the respondent given the particular facts and circumstances in this appeal. The prototype was not even housed in the respondent's premises at all ... Of huge significance is the fact that the prototype was incorporated into and formed part of the whole process or mill operations at Keck Seng, not for a brief while, but for a considerable period of time, some six years or even more.
>
> [177] There were also no indications to warn or alert that the prototype was even a prototype or security measures emplaced to protect or secure the prototype. The 15 feet height of the platform where the prototype was placed does not pose anything unusual from what we can observe of the whole process chain and structure. There is also no evidence of the respondent or even PW1 being present at all times at Keck Seng at least in 2002 when DW2 was lawfully at Keck Seng's factory.
>
> [178] ...
>
> [179] Absent particular arrangements and evidence of security or access restrictions, it would be difficult to impose any duty of confidentiality on third parties such as the second appellant and DW2 who undeniably had a legitimate reason to be present at Keck Seng in 2002, long before the priority date ...

[63] The above-mentioned passages clearly show that the Court of Appeal found as a fact that the prototype/machine at Keck Seng was housed on third party premises, was incorporated and formed part of the whole process or mill operations at Keck Seng for some six years or more, DW2 to whom the prototype/machine at Keck Seng was disclosed was lawfully on Keck Seng's premises and there was no obligation of confidentiality imposed on DW2. We, therefore, agree with the submissions of learned counsel for the respondents to the effect that both questions 4 and 5 are premised on an incorrect fact that the disclosure of the prototype/machine at Keck Seng was 'unauthorised'. This in itself is a sufficient ground for this court to decline to answer questions 5 and 6 (see *Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor (Registrar of Trade Marks, intervener)* [2015] 4 MLJ 166 (FC), and *Ong Leong Chiou & Anor v Keller (M) Sdn Bhd & Ors* [2021] 3 MLJ 622 (FC)).

[64] Still, we will deal with some of the issues raised by the parties as they involved important matter relating to patent law. First, what then constitutes 'disclosed to the public'? It is established principles that where information (whether in documentary form or in the form of the invention itself) has been communicated or made available to at least one member of the public, who is free in law and equity to use it, that information has been disclosed to the public and forms the prior art. However, where such information is communicated under obligation of confidence, it follows that the recipient will not be free in law or equity to use it. Disclosure under such circumstances will not amount to disclosure to the public (see *Bristol-Meyer Co's Application* [1969] RPC 146, *PLG Research Ltd v Ardon International Ltd* [1993] FSR 197, *Quantel Ltd v Spaceward Microsystems Ltd* [1990] RPC 83 (Ch D)). The general principles relating to what constitutes 'disclosed to the public' apply equally to prototype. From decided cases it is clear that in the case of a prototype, if the prototype has been made available to at least one member of the public who is free in law and equity to examine it and/or disclose the information, that prototype has been 'disclosed to the public'. If it was, however, disclosed under an obligation of confidence, it has not been disclosed to the public (see *Lux Traffic Controls Ltd v Pike Signals Ltd* [1993] RPC 107 (Ch D), *Pall Corp v Commercial Hydraulics (Bedford) Ltd* [1990] FSR 329). In respect of prototypes installed on private property, it must be shown that the prototype was actually imparted to at least one person skilled in the art who was free in law to use it or divulge it to anyone else as he pleases in order for the disclosure to amount to disclosure to the public (see *Folding Attic Stairs Ltd v Loft Stairs Co Ltd* [2009] EWHC 1221 (Pat)).

[65] Applying the above principles, we agree with the submission of learned counsel for the respondents that the Court of Appeal correctly held that there was sufficient evidence to establish that the prototype/machine at Keck Seng had been disclosed within the meaning of s 14(2)(a) of the PA 1983. On consideration of all the evidence contained in the appeal record, the Court of Appeal is entitled and correct in making those findings. On the facts the disclosure of the prototype/machine at Keck Seng whilst on the third party private premises were clearly not unauthorised. The prototype/machine at Keck Seng was incorporated into and formed part of the whole process or mill operations at Keck Seng's premises. DW2 was lawfully on the premises and had easy unrestricted access to the prototype/machine at Keck Seng. There were no security measures or evidence of restrictions to access the same. There is further no evidence that obligation of confidence. DW2 was free in law and equity to examine and use the information disclosed by the prototype/machine at Keck Seng. On the facts, we are unable to agree with the submissions of learned counsel for the appellant that the prototype/machine at Keck Seng was installed confidentially or privately.

[66] We have not overlooked the issue that the disclosure in the prior art must be an enabling disclosure to anticipate the claimed invention. It is settled law that for there to be anticipation, there must be an enabling disclosure. A prior art is deemed to have anticipated a patented invention if there is sufficient information conveyed to the public that would enable anyone who is in receipt of the information to be able to reproduce or duplicate the patented invention (see *General Tire & Rubber Company*, *Generics (UK) Ltd and others v H Lundbeck A/S* [2009] 2 All ER 955, *Spind Malaysia Sdn Bhd*, *Genelabs Diagnostics Pte Ltd v Institut Pasteur & Anor* [2001] 1 SLR 121 and *Stanway Oyster Cylinders Pty Ltd v Marks* (1996) 144 ALR 627).

[67] Reverting to the present case, the Court of Appeal also went on to consider whether the disclosure was an 'enabling disclosure'. In this regard, the Court of Appeal at para 194 of its grounds of judgment held:

> [194] DW2's observations of the machine at Keck Seng obviously was sufficient to enable him to learn from the machine and make one for Kim Loong in 2002/2003. The Kim Loong drawings corroborate the second appellant's case. DW2 explained himself as someone who was skilled in the art here and who was able to follow the operations of the machine and learnt from it.

[68] Earlier, at para 162 the Court of Appeal observed:

> [162] DW2 had 'observed the operation of the machine' and had learnt from if to the extent that he or the second appellant went on to build one for Kim Loong. DW2 even prepared the Kim Loong drawings based on his observations of the operations of the machine/prototype. And this was in 2002 with the machine built for Kim Loong in 2003.

[69] We find no plausible reasons to interfere with the findings of the Court of Appeal that the disclosure was an enabling disclosure.

[70] Based on all the above reasoning, since questions 4 and 5 are in substance premised on fact which is in direct contradiction with the findings of fact by the Court of Appeal and that the questions posed are subject to factual findings, we find it unnecessary to answer both questions.

Question 6

[71] This question essentially addresses whether the court must examine each and every dependent claim and thereafter decide individually if the claim is valid and infringed.

[72] We can deal with this question more briefly as the question of law has been answered in *Merck Sharp & Dohme Corp & Anor v Hovid Bhd* [2019] 12 MLJ 66 (FC) ('*Merck Sharp* (FC)'), where it was decided, inter alia, that the

courts must construe and decide on the validity of the dependent claims separately even if the independent claim is adjudged to be invalid. In the words of *Merck Sharp* (FC):

> [124] For all these reasons we are constrained to depart from the decision in SKB Shutters. We reiterate that it is essential that when a court is tasked with ascertaining the validity of a patent comprising both independent and dependent claims, the trial court is bound to evidentially assess each of these claims separately.

Contentions of parties in respect of question 6

[73] The appellant contended that this question stemmed from the Court of Appeal's finding that the patent's dependent claims 2–12 were invalid as a consequence of the invalidity the independent claim. The Court of Appeal's decision on this issue is erroneous and unsustainable as it is inconsistent *Merck*, which decided, inter alia, that the courts must construe and decide on the validity of the dependent claims separately even if the independent claim is adjudged to be invalid.

[74] The respondents contended that the Court of Appeal did not conclude that the dependent claims 2–12 were invalid by reason of the invalidity of the independent claim 1.

Analysis and findings in respect of question 6

[75] We agree with the submissions of learned counsel for the respondents that the Court of Appeal did not conclude that the dependent claims 2–12 were invalid by reason of the invalidity of the independent claim 1. This can be seen from the judgment of the Court of Appeal as follows:

> Dependent claims
>
> [231] Our view remains unchanged even when we consider the dependent claims; whether in the configuration of the spikes; the shape of make of the spikes; the adjustable gap between the two drums; the nature of the body frame; the power source including the mechanical gearbox system; the control unit; or even in the way those drums rotate when powered. These features present and were already anticipated in each of the prior art discussed; especially in the prototype and the Desa Kim Loong Machine.
>
> [232] The claims in 2 to 12 are thus similarly invalid for the reasons discussed.
>
> [234] For the reasons set out above, the appeal ought to be allowed and the decision of the High Court be set aside. With the above conclusions, the matter of infringement further does not arise.

[76] In the other parts of the grounds of judgment, the Court of Appeal examined each dependent claim individually prior to coming to the decision that the dependent claims were invalid. This can be seen from their specific

reference to the various features of each dependent claim at para 231 of the grounds as well as at paras 113–123 of the judgment. We conclude that in line with *Merck Sharp* (FC), the Court of Appeal did examine each dependent claim individually when coming to their decision that each dependent claim was invalid.

[77] In the circumstances of this case, it is unnecessary to answer question 6.

Conclusion on the questions relating to patent law

[78] We affirmed the specific findings of the Court of Appeal on the fact that the invention which is the subject the appellant's patent is not new by reason of the prior disclosure of the prototype/machine at Keck Seng within the meaning and conditions of s 14(2)(a) of the PA 1983 and therefore the appellant's patent was invalid.

[79] For all these reasons, we unanimously dismiss the appellant's appeal relating to the appellant's patent.

Rohana Yusuf PCA (delivering judgment of the court):

Question 7

[80] We now come to the sole question posed on the issue pertaining to copyright in question 7. We hereby reproduce it again for clarity and convenience and it reads as below:

> Having regard to the concept of originality in copyright law which is distinct from the concept of novelty in patent law, whether the design drawings of an article ('the Work') would independently be eligible for copyright protection under s 7(2), 2A and (4) of the Copyright Act 1987 as artistic works?

[81] This question raises the issue on the applicable test of 'originality' for subsistence of copyright, and whether it is distinct from the concept of novelty in patent law.

[82] In gist, the appellant's case on copyright is that the design drawings of its fruit bunch splitter were created by one of its employees. And these design drawings have been reduced to material form. The said author or creator, PW1 being an employee of the appellant, had expended substantial effort to render it original in character as envisaged under the copyright law.

[83] The appellant further maintained that the design drawings are artistic works within the meaning of s 7(1)(c) of the Copyright Act 1987 ('the CA

1987'). Pursuant to s 42 of the CA 1987, PW1 had stated that he indeed had expended substantial effort into the design drawings of the fruit bunch splitter.

[84] While the respondents' case in summary is this: No copyright subsisted in the said design drawings of the appellant since the works involved were not original. According to the respondents there had been existing prior arts in the design drawing of Kim Loong's machine in the year 2003, where the appellant had in fact copied from, when the appellant produced the design drawings of its fruit bunch splitter in the year 2004.

[85] The respondents then maintained that even if copyright subsisted there was no infringement of the appellant's fruit bunch splitter drawings, firstly because there was no causal connection. Secondly the respondents' SK Machines were adapted from an earlier prior art; Kim Loong drawing which was created earlier than the appellant fruit bunch splitter.

Decision of the High Court

[86] The High Court allowed the appellant's claim on copyright and found in summary as follows:

(a) there is copyright subsisting in the copyrighted works and three-dimensional embodiment of the machine belonging to the appellant. Reliance was placed by the High Court on the statutory declaration affirmed by PW1 which the High Court found to be unrebutted by the respondents;

(b) there is an infringement of copyright by the respondents, and all the following ingredients have been met; in that:

(i) there is sufficient objective similarity between the respondents' SK Machines and copyrighted works as set out in Annexure G (our perusal of the appeal record showed that this Annexure was found in the appellant's submission at the High Court after trial);

(ii) there is a causal connection between appellant's fruit bunch splitter and SK Machines through the inference of copying (based on the substantial similarities); and

(iii) the similarities between the appellant's fruit bunch splitter as shown through the copyrighted works and the SK Machines constitute a substantial part of the original work.

Decision of the Court of Appeal

[87] The Court of Appeal disagreed with the High Court. The Court of Appeal in its judgment, held these:

[262] From the sequence of events and for the reasons and findings as discussed above in relation to the patent, we find that there cannot be any copyright in view of the existence of the prior art documents relied on by the appellants. This includes the Prototype and the Desa Kim Loong Machine.

[263] This makes the respondents' drawings in fact substantial reproductions of the Desa Kim Loong Machine and/or the other prior art documents relied on by the appellants in which case, it cannot be said that the respondent had expended sufficient skill and effort to render the original as mandated by the provisions of the Copyright Act 1987 [Act 332].

(The appellant referred to in the above is the respondents in this appeal, and vice versa).

[88] It can be discerned from the finding of the Court of Appeal above that there cannot be subsisting copyright in the appellant's design drawings for the reasons; Firstly that there is no novelty in view of the existence of prior arts in the form of the unpleaded Desa Kim Loong Machine and the prototype of the fruit bunch splitter, rendering the appellant's design drawings to be not a new or original design. Secondly, the Court of Appeal found that the appellant had failed to fulfil the requirement of s 7(3) of the CA 1987 in that the appellant failed to prove there was sufficient effort rendered in the design drawings in order to confer the appellant the negative rights laid out in s 13(1) of the Act.

[89] The Court of Appeal went on further to hold that even if copyright subsists, there can be no infringement as there was no causal connection established.

Contention of parties on question 7

[90] On the issue of subsistence of copyright, the appellant had criticised the Court of Appeal's finding and submitted that it had erred in its findings that no copyright subsisted due to their lack of 'originality'. The lacking in originality as found by the Court of Appeal which was grounded purely on the basis of the existence of the alleged prior work as determined in the patent proceedings was not the correct test to be employed. In short, it was contended that the Court of Appeal should not have conflated the test for patent with that of copyright.

[91] It was the case of the appellant that the denial of the subsistence copyright in the works for want of novelty or inventiveness as used in the patent proceedings, was unprecedented and not in accord with the settled legal test employed in copyright law. In doing so, the appellant contended, the Court of Appeal had in fact equated the concepts of 'originality' in copyright law with 'novelty' in patent law as one and the same.

[92] Counsel for the appellant argued, the issue as to whether a work is a 'substantial reproduction' of another prior art is only relevant to determine infringement of copyright but not to determine the subsistence of copyright. It was further submitted, in any event the scope of originality in copyright is wide. It includes a situation where a creator of later work, having taken original elements in an earlier copyright work but at the same time expended labour and skill in creating his works. Pursuant to s 7(4) of the CA 1987, having expending on an earlier work the appellant is entitled to the protection as articulated in s 13(1). The appellant hence cannot be denied of those rights, even if it merely copied the earlier works once it is proven that it had indeed contributed and expended on those earlier works.

[93] The appellant submitted, PW1 the author of the appellant's design drawings had testified at length before the learned trial judge on the substantial efforts he had taken in coming up with the design drawings. Particularly in his Q&A: 51–53 he testified the effort taken by him in that design drawings which in law entitled the appellant to the right in copyright.

[94] To reinforce his expended effort PW1 had also referred to a statutory declaration affirmed by him on 5 December 2011 pursuant to s 42 of the CA 1987. In his statutory declaration, he explained that there are two sets of design drawings created by him at two different stages. The first part of the work was created on or before February 2004 which consisted of a simple schematic drawing. The second part of the work constituted the refined engineering drawing with a very detailed rendition.

[95] The respondents had no difficulty in agreeing that the concept of 'originality' in copyright law is distinct from the concept of 'novelty' in patent law. However, the respondents maintained, the Court of Appeal was correct in holding no copyright subsisted in view of the existence of prior arts, and that the appellant had not proven to have expended sufficient skills and effort to render the drawings original. According to the respondents, in arriving at the above decision, the Court of Appeal had clearly addressed its mind to the correct provisions of the CA 1987, particularly s 7(3)(a).

[96] The respondent contended, the Court of Appeal was correct in making reference to the prior arts documents in the following context; With the existence of the prior arts documents, no effort could have been expended in the creation of the appellant's design drawings to render the same original in copyright law. The design drawings of the appellant were furthermore a substantial reproduction of the other prior arts such as the prototype and Desa Kim Loong Machine. Moreover, according to the respondents, the Court of Appeal did not rule that the mere existence of prior arts, would automatically negate the eligibility for copyright protection.

Finding and analysis on question 7

[97] We agree with the appellant that the test applicable on the subsistence of the copyright is not 'newness' or 'novelty'. This too seems to be the position taken by the respondents. The different legal test in patent and copyright was explained by the High Court in *Radion Trading Sdn Bhd v Sin Besteam Equipment Sdn Bhd & Ors* [2010] 9 MLJ 648. Clearly deliberated by Azahar Mohamed J (now CJM) in that case, patent and copyright are two distinct fields of intellectual property law. The basis of patent is the novelty of the subject invention and the notion of originality in copyright law is not the same as novelty found in patent law. His Lordship in that case had clarified clearly this legal proposition in the following way:

> It is incorrect to employ the claims in a patent specification to regulate or limit the scope of copyright protection over an artistic work of a device, which may incidentally correlate or form part of the patented invention (see para 33).

[98] In determining the subsistence of copyright reference has first to be made to s 7 of the CA 1987. The relevant provisions are as follows:

> 7 Works eligible for copyright.
>
> (1) Subject to this section, the following works shall be eligible for copyright:
>
> (a) literary works;
>
> (b) musical works;
>
> (c) artistic works;
>
> (d) films;
>
> (e) sound recordings; and
>
> (f) broadcasts.
>
> (2) Works shall be protected irrespective of their quality and the purpose for which they were created.
>
> (2A) Copyright protection shall not extend to any idea, procedure, method of operation or mathematical concept as such.
>
> (3) A literary, musical, or artistic work shall not be eligible for copyright unless —
>
> (a) sufficient effort has been expended to make the work original in character; and
>
> (b) the work has been written down, recorded, or otherwise reduced to material form.
>
> (4) A work shall not be ineligible for copyright by reason only that the making of the work, or the doing of any act in relation to the work involves an infringement of copyright in some other work.

[99] Pursuant to s 7(1) above, 'artistic works' are eligible for copyright. Artistic works are defined in s 3 to include a 'graphic work' which in turn is defined to include any 'drawing'.

[100] Section 7(3) qualifies further to provide that in order for artistic works to be eligible for copyright, sufficient efforts must have been expended to make the artistic works, including drawing, original in character and the works must have been reduced to material form. However, the fact that a work is based on the existing work, or parts of the work is lifted from another work will not prevent it from being original as stated in s 7(4) of the CA 1987.

[101] It can be summed up from the above provisions that, for copyright to subsist, the work must be: (i) original; (ii) complies with the requirement as to form; (iii) belongs to one of the categories of protected works; and (iv) complies with the qualifications for copyright. Once these requirements are fulfilled, a work is protected irrespective of quality and the purpose for which it was created (see Khaw Lake Tee and Tay Pek San, Khaw on *Copyright Law in Malaysia* (4th Ed, Lexis Nexis 2017) 33).

[102] The concept of 'originality' in copyright was addressed and carefully deliberated in the English case of *University Of London Press, Limited v University Tutorial Press, Limited* [1916] 2 Ch 601. Similar concept was adopted by this court in *Lau Foo Sun v Government of Malaysia* [1974] 1 MLJ 28 and *Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor* [2015] 3 MLJ 1. In *Dura-Mine*, this court had emphasised that it was not a requirement for the expression to be in an original or novel form before a copyright can be said to subsist. The copyright law does not require that a work should be unprecedented or new in comparison with already existing works.

[103] What we can conclude from the above discourse is that, the concept of 'newness' or 'novelty' in the patent law is not a relevant consideration for copyright to subsist. What is more important is that sufficient efforts have been expended to render the work original in copyright law as clearly articulated in s 7(3)(a).

[104] Back to the facts before us, it can be safely concluded therefore that even if the earlier prior arts, particularly the prototype or Desa Kim Loong Machine were already in existence before the appellant's design drawings, the appellant's copyright would still subsist and would not be negated by the existence of the earlier prior arts as provided under s 7(4) of the CA 1987. In the first place reference to Desa Kim Loong Machine has to be rejected, for want of pleading as earlier alluded to in this judgment.

[105] The application of this provision of the law was explained by Associate

Professor Dr Tay Pek San in *Intellectual Property Law in Malaysia* (2nd Ed, Sweet Maxwell 2020) where it was observed that a creator or author of an original work is entitled to copyright even though he may have infringed the copyright of any work which he has drawn or copied from.

[106] The legal proposition is clear that a work shall not be ineligible for copyright merely by reason that the making of the work involves an infringement of copyright in some earlier or other works. What is essential for a subsistence of copyright in such work is the sufficient effort expended in terms of time, labour, and skills to render the same original.

[107] We note that it was the finding of the High Court that the veracity of the content in PW1's statutory declaration was neither challenged nor rebutted by the respondents during the trial. It was on this basis that the learned trial judge supported his findings on the subsistence of copyright of the appellant. This is a finding of fact supported by sound reasons and evidence which the appellate court should not have interfered with.

[108] From its grounds of judgment the Court of Appeal failed to consider this piece of evidence as found and relied upon by the learned trial judge. This evidence supported the finding by the trial judge that the basic test required under s 7(3)(a) of the CA 1987 had been met by the appellant. In doing so, the Court of Appeal had failed to consider the substantive effort elicited from the evidence of PW1, which substantiated the High Court's finding that the appellant had complied with s 7(3)(a). Our perusal of the grounds of judgment of the Court of Appeal reveals that this unrebutted evidence found by the High Court had escaped its consideration.

[109] The Court of Appeal had failed to consider or analyse the evidence relied upon by the learned judge when it concluded that the appellant failed to prove that s 7(3)(a) had been complied. This finding of fact by the trial judge was made after weighing the evidence of PW1 during the trial which appellate intervention is best refrained unless the trial court was plainly wrong.

[110] Hence, we agree with the finding of the learned trial judge that there were substantive efforts made by the appellant to entitle itself to the subsistence of copyright in the appellant's design drawings.

Question of law and conclusion

[111] We therefore agree with the appellant that the question No 7 posed should be answered in the affirmative. In view of the above finding, it would be incumbent upon this court to deliberate on the consequence and implication of this finding, viz; whether there is an infringement of that copyright. Learned

A respondents' counsel raised issues and submitted that there was no question of law posed pertaining to infringement of copyright for this court to answer. It was further contended that since there was no appeal to be deliberated by this court on infringement of copyright, the decision of the Court of Appeal that there was no infringement must remain.

B

[112] Having considered the resistance raised by the respondents we are of the view that infringement of copyright in this appeal is consequential to our finding that copyright subsisted in the appellant's design drawings. Without deliberating on the consequence of this finding, it would render such a finding C meaningless. It will not result in a proper determination of this appeal.

[113] In this regard, even though the question of law posed does not relate to infringement of copyright, the issue of infringement is a substantial merit to be D dealt along with finding on the copyright subsistence as the copyrighted work is protected from any substantial reproduction or infringement under s 13(1).

[114] It is often said a court will not act in vain. No court should delve into making a meaningless order. To render the finding of subsistence of copyright E meaningful, it is only appropriate and logical that this court deliberates on this consequential issue.

[115] This court had already ruled and reminded in *Palm Oil Research and Development Board Malaysia & Anor v Premium Vegetable Oils Sdn Bhd & another appeal* [2005] 3 MLJ 97 that although leave is granted sparingly, once F granted, it is not bound hand and foot to limit itself to the framed issues. The court may deal with any matter which it considers relevant for the purpose of doing complete justice in accordance with the substantial merits of a particular G case.

[116] To recapitulate, the High Court concluded and found infringement of copyright against the respondents. In its grounds of judgment, the High Court reiterated that the requisite tests to infringement had been met. The High H Court, as we have earlier alluded to had concluded there was sufficient objective similarity between the respondents' SK Machines and copyrighted works in Annexure G of the appellant's submission. We note that the High Court had referred to Annexure G which was attached to the appellant's submission made after trial. As such it is not clear as to which evidence His I Lordship was referring to when he cited Annexure G produced during the submission of the appellant before it. Premised on that Annexure G His Lordship found that there was a causal connection between the appellant's fruit bunch splitter and SK Machines and the said similarities constitute a substantial part of the copyrighted work.

[117] Despite concluding that all the three elements above have been met, we see no further deliberation or analysis being taken by the learned High Court Judge on what are the objective similarities and the substantial reproduction that His Lordship had found. On these two elements, the learned judge simply stated in his judgment that there was sufficient objective similarity between the respondents' SK Machines and the copyrighted works (as set out in Annexure G) without more (see para 49).

[118] The learned judge did not analyse how the element of copying a substantial part of the copyrighted work had taken place. All that His Lordship had stated in the grounds of judgment was simply that there was sufficient objective similarity between the SK Machines and the appellant's design drawings. His Lordship too did not explain how and why and what were the similarities which constitute a substantial part of the copyrighted work.

[119] On the element of causal connection, the learned trial judge had concluded at para 48 of his judgment that His Lordship's finding was essentially premised on two main reasons. First, there was accessibility to the design drawings, according to the learned trial judge when the demonstration of the appellant's fruit bunch splitter took place at the first respondent's mill for two days on 24 April 2009 and 25 April 2009. After that demonstration, a quotation was sent by the appellant to the first respondent, of its fruit bunch splitter model KH-7. This quotation was said to have provided the breakdown costs for the supply and installation of the machine, together with other relevant machineries at the said premises. The quotation was also found to have consisted specific dimensions and specifications of these machineries. Accordingly a detailed machinery layout technical drawing dated 22 April 2009 was also sent together with the quotation. This appears to be the other reason cited by His Lordship.

[120] The High Court then noted that, the first respondent however instead of purchasing the fruit bunch splitter from the appellant went on to purchase SK Machine from the second respondent. This took place about a few months later and not long after the said demonstration was held at the first respondent's mill.

[121] To further support the issue on causal connection, the High Court went on to find the respondents' SK Machines' reinforcement bars to be a feature similarly found in the appellant's fruit bunch splitter. As explained by PW1 in his evidence, the reinforcement bars were only introduced by the appellant in 2008, which was after the Kim Loong drawing was created.

[122] The learned trial judge also found the bearing housing in the SK Machines which are embedded within the body frame to be similar to that of

A the appellant's fruit bunch splitter. This feature is different from Kim Loong drawing because in Kim Loong drawing the bearing housing is located outside the casing.

B **[123]** The Court of Appeal disagreed with the High Court and found no causal connection. The reasons provided by the Court of Appeal are as stated at paras 270–272 of its grounds of judgment. After a careful deliberation, the Court of Appeal found the quotation sent to the respondent was not forwarded with detailed technical drawings as suggested by the High Court. Moreover the drawing that was sent was in fact not the alleged copyrighted works. This was C because the technical drawing enclosed with the quotation was a drawing dated 2009, whereas the pleaded design drawings were that of 2004.

D **[124]** On top and above that, the Court of Appeal had analysed and considered the evidence of DW2 who is the creator of the SK Machines. DW2 testified, he was not present during the demonstration. DW2 even admitted that the SK Machines were adapted from Kim Loong drawing which was created on first June 2003. It was against the backdrop of these evidence of other prior arts, that the Kim Loong machine was manufactured by the second E respondent in 2003. The Court of Appeal therefore found no causal connection between SK Machines with the appellant's design drawings which were created in 2004.

THE LAW ON INFRINGEMENT OF COPYRIGHT

F **[125]** The infringement of copyright is dealt with in s 36 read together with s 13(1) of the CA 1987. Copyright is infringed under s 36, by any person who does, or causes any other persons to do, without the license of the owner of the copyright an act, the doing of which is controlled by copyright under the Act.

G **[126]** Amongst the acts controlled by copyright law under the Act are stipulated under s 13(1) which gives the exclusive right against:

> (a) the reproduction in any material form;
> ...
> H (b) the distribution of copies to the public by sale or other transfer of ownership;
> ...
>
> of the whole work or a substantial part thereof, either in its original or derivative form.

I **[127]** The three elements required for establishing copyright infringement are set out in the High Court case of *Megnaway Enterprise Sdn Bhd v Soon Lian Hock (sole proprietor of the firm Performance Audio & Car Accessories Enterprise)* [2009] 3 MLJ 525. It referred to the three essential elements

constituting copyright infringement as set out by the English case of *Purefoy Engineering Co Ltd v Sykes Boxall & Co Ltd, Sykes and Boxall* (1955) 72 RPC 89.

[128] The learned trial judge in *Megnaway* too referred to the text by Professor Dr Khaw Lake Tee in *Copyright Law in Malaysia* (1st Ed, Butterworths Asia 1994) where at paras 87–88, she explains that for purposes of direct infringement, it must be established that:

(a) There is *sufficient objective similarity* between the original work or a substantial part thereof, and the infringing copy;

(b) There is a *causal connection* between the original work and the infringing copy, that is, the infringing copy must have been copied from the original work, whether directly or indirectly; and

(c) What has been infringed must constitute a substantial part of the original work.

[129] From the above discussions the law on infringement of copyright is clear and well settled. To prove direct infringement of copyright, all the three elements must be present cumulatively. These three elements are; sufficient objective similarity, and substantial reproduction of the copyrighted and there must be a causal connection between the two works.

[130] In determining sufficient objective similarity between the two works, Gunn Chit Tuan J in *Longman Malaysia Sdn Bhd v Pustaka Delta Pelajaran Sdn Bhd* [1987] 2 MLJ 359 held that besides proving there is objective similarity, there must also be established that the degree of the objective similarity must be substantial. His Lordship went on to explain that the substantiality is required to be established not merely because of the physical amount of reproduction, but more because of the substantial significance of that which was copied. This principle is important to be borne in mind in order to ensure that the particular similarities relied on, are more likely to be the result of copying and not of mere coincidence.

[131] In the appeal before us, the learned trial judge did not undertaken to examine and evaluate on evidence, the distinct materials and features of both works in question. By merely stating that the three requirements of infringements were met without any deliberation and explanation, the learned trial judge has not satisfied to sufficiently deliberate whether the SK Machines was a reproduction of the appellant's design drawings.

[132] In this regard, this court is guided by its decision in *Mohd Syamsul bin Md Yusof & Ors v Elias bin Idris* [2019] 4 MLJ 788. It was held that it is the duty of the court to examine and evaluate, on evidence, the distinct materials and

features of both works in question. Only with such examination and evaluation, the court will be able to make a good comparison to determine similarities and differences between the two works. Essential features and other related elements must be decided based on evidence. This is to enable the court to determine whether the similarities are substantial or not, in light of the whole features contained in the two works. Such determination can only be done after examining and evaluating all evidence available but not by referring only to the statement of claim and pleadings.

[133] The learned trial judge had failed to adhere to the requirement in *Longman.* His Lordship failed to examine whether or not even if the copyrighted works were copied, do they amount to a substantial significance of the copyrighted works.

[134] On this issue, we agree with the Court of Appeal that even if there was access to the design drawings as alleged, the quotation sent to the first respondent was on 22 April 2009. There was no explanation if indeed the technical drawing sent in 2009 was the same technical drawings of 2004 that formed the basis of the appellant's pleaded case. It also did not help the appellant's case when DW2 on behalf of the respondents testified that the SK Machines were adapted from the Kim Loong drawing which was created in 2003. The Court of Appeal further took into account the evidence of DW2 that he was not present at the demonstration to enable him to copy. The High Court did not consider this relevant evidence in its judgment.

[135] The need to prove causal connection between the two works are indispensable as copyright work must be shown to be a *causa sine qua non* of the infringing work. As clearly stated by Diplock LJ in *Francis Day & Hunter Ltd and another v Bron and another* [1963] Ch 587, which was referred in the case of *Elster Metering Limited & Anor v Damini Corporation Sdn Bhd & Anor* [2012] MLJU 1753 'If the existence of the copyright work has no causal connection with the production of the alleged infringing work (even though the latter be identical with the former) there is no infringement of copyright'.

[136] To succeed on a claim on infringement the appellant bears the burden of proving the elements of sufficient objective similarity and causal connection between the two works as outlined. The burden is always on the appellant to establish those. ingredients by evidence, only then it will give rise to an inference that respondents had copied the appellant's work. The burden on the respondents then is to rebut that inference. The appellant had failed to establish all these three elements cumulatively to succeed on its claim of infringement.

[137] On the reasons given, we agree with the Court of Appeal that the

appellant had failed to establish that the respondents in fact have access to the appellant's design drawings.

[138] For all the reasons stated above, we agree with the Court of Appeal that the appellant had failed to establish any infringement of the copyright. Though we agree with the learned High Court judge that copyright subsists in the design drawings of the appellant but no infringement of copyright has been established.

[139] In the result, the appellant's appeal on the claim relating to copyright is also unanimously dismissed. We make no order on costs.

Appeal dismissed.

Reported by Ashok Kumar